



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Nao ASA et al.

Group Art Unit: 1794

Application No.: 10/516,073

Examiner: E. WOOD

Filed: November 29, 2004

Docket No.: 121926

For: SYNTHETIC RESIN CONTAINER WITH EXCELLENT FUNCTIONAL PROPERTIES, AND PRODUCTION METHOD THEREFOR

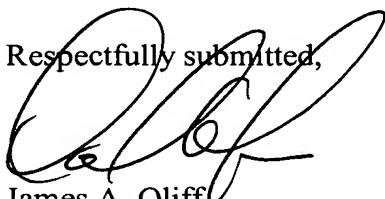
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This request is being filed with a Notice of Appeal. Review of the April 16, 2008 Final Rejection is requested for the reasons set forth in the attached five or fewer sheets.

Should any questions arise regarding this submission, or the Review Panel believe that anything further would be desirable in order to place this application in even better condition for allowance, the Review Panel is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,

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JAO:DAT

Date: June 2, 2008

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REMARKS

Claims 1-13 are pending in this application. The Office Action, in paragraph 2, rejects claims 1-7 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,929,836 to Kikuchi et al. (hereinafter "Kikuchi"). This rejection is respectfully traversed.

Claim 1 recites, among other features, a synthetic resin container having excellent gas barrier property and heat resistance, wherein said container comprises a matrix that is blended with a gas barrier material and wherein said container is produced by a process including biaxial stretch blow molding steps performed at least twice with a heat treatment step therebetween. Claims 3 and 6 recite similar features. With general reference to certain disclosures in Kikuchi, the Office Action alleges that Kikuchi can reasonably be considered to teach all of the features positively recited in, for example, independent claim 1. The analysis of the Office Action fails for at least the following reason.

Kikuchi teaches a multi-layered preform and multi-layered bottle manufactured by using the same for substantially preventing the generation of strains in obtaining improved stress cracking resistance with excellent appearance (Abstract). As did the previous Office Action, the Office Action alleges that this reference can reasonably be considered to teach all of the features positively recited above with respect to at least independent claim 1. In response to the previous Office Action, Applicants argued the following. Kikuchi, in its teaching of a multi-layered bottle, does not teach, nor would it have suggested, said container comprises a matrix that has blended with a gas barrier material as recited, among other features, in independent claim 1, or the blow molding steps for making such a bottle as are positively recited in independent claim 6. Specifically, the multi-layered design of Kikuchi cannot reasonably be considered to anticipate the mixed-matrix layer material that is positively recited in independent claims 1 and 6. This Office Action ignores Applicants' arguments in this regard and continues to fail to show how Kikuchi can reasonably be

considered to teach, or to have suggested, such a feature. Kikuchi is specifically drawn to a multi-layered design. The requirements of the multi-layered design in Kikuchi are specifically set forth. Kikuchi does not abandon the multi-layered design of the prior art, even in view of certain positively disclosed shortfalls in the multi-layered design. For at least this reason, Kikuchi cannot reasonably be relied upon, in rendering anticipated the subject matter of independent claims 1 and 6, and the claims depending therefrom.

Applicants also argued that the stretching rod stretching and the blown air stretching of Kikuchi cannot reasonably be considered to correspond to "bi-axial stretch blow molding steps performed at least twice," as are positively recited, among other features, in independent claims 1, 3 and 6. Additionally, the fact that Kikuchi asserts that a heat set "may be performed" does not teach further that a heat treatment step occurs between any alleged separate bi-axial blow molding step as is recited, among other features, in independent claims 1, 3 and 6. In an attempt to rebut Applicants' previously-made arguments, the Office Action paraphrases the subject matter of the pending claims and applies an improper standard for a showing of inherency in the Response to Arguments portion set forth on page 8 the current Office Action.

The Office Action alleges that because Kikuchi teaches blow molding and "maybe" heating that it necessarily teaches a two-step blow molding process. The Office Action should not paraphrase Applicants' specifically-recited claim features in a manner that would render those specifically-recited claim features essentially vitiated. It is not reasonable to construe the claims in the manner that the Office Action must in order to find anticipated the subject matter of the pending claims. The conclusions of the Office Action are based on reading the claims in a manner that would assert that if there is a blow molding step and a heating step then the subject matter of the pending claims is present. Unfortunately, this interpretation of the claim language does not give plain meaning and proper construction to

the positively-recited claim terms in any of independent claims 1, 3 and 6. As quoted above, the claims include features of bi-axial stretch blow molding steps performed at least twice, with a heat treatment step therebetween. Kikuchi in its teaching of a single stretching step, albeit by different mechanisms in a longitudinal and lateral direction, cannot reasonably be construed as teaching two separate bi-axial blow molding steps with an intervening heat treatment step.

Further, the Office Action's approach in finding "inherent" features that are not explicitly disclosed in Kikuchi strains the application of §102. To any extent that Kikuchi teaches a heat treatment step, the reference asserts that "a heat set may be performed." The Federal Circuit has been clear in its interpretation of applying the theory of inherency in order that Office Actions cannot allege features not explicitly taught by a reference considered implied by the teachings of a reference. MPEP §2112 states that the Patent Office must provide rationale or evidence tending to show inherency. Citing *In re Robertson* (citations omitted), MPEP §2112 states, "[i]nherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Additionally, citing *Ex parte Levy* (citations omitted), §2112 goes on to state that "[i]n relying upon a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teachings of the applied art" (emphasis in original). The fact that the reference teaches that a heat set "may be" performed does not meet the applicable standard. In other words, a "may be" heat set performance in the reference cannot be relied upon as necessarily teaching a bi-axial stretch blow molding step being performed, a heat treatment step then being performed, and a separate bi-axial stretch blow molding step then being performed as is positively recited among other features in the pending independent claims 1, 3 and 6.

For at least its failure to address the single layer structure recited in claim 1, and the overly broad construction of the features positively recited in independent claims 1, 3 and 6 (failing to give each of the positively recited claim features their plain meaning), and an improper application of the law of inherency, the Office Action fails in showing how Kikuchi can reasonably be considered to teach, or to have suggested, the combinations of all of the features positively recited in independent claims 1, 3 and 6.

For at least the foregoing reasons, independent claims 1, 3 and 6 are neither taught, nor would they have been suggested, by Kikuchi. Further, claims 2, 4, 5 and 7 are neither taught, nor would they have been suggested, by Kikuchi for at least the respective dependence of these claims directly or indirectly on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

The Office Action, in paragraph 3, rejects claims 8-13 under 35 U.S.C. §103(a) as being unpatentable over Kikuchi in view of U.S. Patent No. 5,735,420 to Nakamaki et al. (hereinafter "Nakamaki"). This rejection is respectfully traversed.

For all of the reasons set forth above, this combination of applied references cannot reasonably be considered to have suggested the combinations of all the features positively recited in independent claim 8. Nakamaki does not overcome the above-identified shortfalls in the application of Kikuchi to the subject matter of the pending claim. In fact, the Office Action, on page 6, continues to be overly broadly apply an obviousness analysis to claim 8, and the claims depending therefrom. The Office Action concedes that Kikuchi is silent with respect to blend ratios of gas barrier material and the exact methods of the step blow molding technique. This last assertion provides further evidence that the Office Action fails in showing the exact method of the step blow molding technique recited in claims 1-7.

Further, the broad statements regarding discovery of optimum or workable ranges by routine experimentation are belied by the fact that there is no reference in the Office Action to

any alleged ranges disclosed in the references. Claim 8 recites some very specific ranges, which, as discussed in Applicants' disclosure, provide a specific benefit. It is not as easy a matter, as the Office Action attempts to assert that optimal ranges could have been arrived at via routine experimentation.

First, the Office Action fails to establish the precedential condition that these ranges are considered result-effective variables, which would be subject to optimization through routine experimentation. Additionally, Federal Circuit precedent teaches that simply because references may be relied upon as disclosing general concepts, specific ranges, even within the generally disclosed ranges, even if those existed, which result in unpredictable or unforeseen benefit may not be anticipated by the general ranges, which clearly did not recognize the specific unforeseen or unpredictable benefit. Finally, the broad assertion that it would have been obvious to combine the references in the manner suggested is not shown by applying any rationale, as the MPEP indicates should be included in a post-*KSR* analysis for combining references. In other words, it has not been adequately shown by the use of the mere conclusory statement in the Office Action that one of ordinary skill would have predictably combined these references in the manner suggested to render obvious the subject matter of the pending claims. In this regard, it should be noted that Kikuchi and Nakamaki are commonly owned. While they both deal with details of bi-axially stretched blow molded containers, that is where any relationship between the subject matter disclosed in either of these references ends.

For at least the foregoing reasons, any permissible combination of Kikuchi and Nakamaki cannot reasonably be considered to have suggested the combination of all the features positively recited in independent claim 8. Further, claims 9-13 also would not have been suggested by this combination of references for at least the respective dependence of these claims directly or indirectly on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites.